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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,865	06/07/2001	Mark Andrew Benny	AUS9-2001-0208-US1	9366
7590 Kelly K. Kordzik 5400 Renaissance Tower 1201 Elm Street Dallas, TX 75270			EXAMINER FREID, RUSSELL WARREN	
			ART UNIT	PAPER NUMBER
			2128	
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			03/13/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/875,865

**Applicant(s)**

BENNY ET AL.

**Examiner**

Russell Frejnd

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### ***Examination of Application #09/875,865***

1. This communication is in response to applicant's Second Appeal Brief received 8-November-2007. Claims 25-30 are pending in the application, and prosecution of these claims is reopened. Claims 1-24 were cancelled by applicant's amendment received 29-April-2005.

The following statements reinstate a rejection under 101, maintain the rejection under double patenting, and provide a new art rejection utilizing a new reference. Also, the examiner respectfully thanks applicant for submission of the Terminal Disclaimer received on 24-April-2006, pertaining to the present application and USP Application 09/875,863.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, claim 28 recites a *"computer program product for storage on a computer readable medium..."*. The word *"for"* infers an intended use of the *"computer program product"*, as opposed to a positively recited embodiment. In other words, the claim does not necessitate that the *"computer program product"* be physically embodied on a *"computer readable medium"*. It is therefore directed to a program per se and not to a process occurring as a result of executing the program. The claim is also not directed to a machine programmed to operate in accordance with the program, nor to a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter and is therefore nonstatutory. **See MPEP Section 2106.01**

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Furthermore, even if the “*computer program product*” were to be positively recited as a storage embodiment, the limitation “*storage on a computer readable medium*” is deemed to be directed to non-statutory subject matter. On page 37 of Applicant’s specification, lines 3-5 state that the “*computer program product*” can be transmitted. Then, lines 5-8 state that the act of storing instructions/program on a medium effects a physical change of that medium, where the medium may then be electrical, magnetic, etc. Based on the context presented in the specification, it is reasonable to interpret “storage on a computer readable medium” to include transmission of the “computer program product” via electrical or magnetic means, i.e. signal. This does not fall within any of the statutory categories and is therefore not patentable subject matter. **See MPEP Section 2106 IV.B.¶4 and Section 2106.01**

Claims 29 and 30 are not deemed to be statutory, due to their dependence on claim 28.

### ***Double Patenting Rejections***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ommum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.3218 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.1 Claims 25-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-25 of U.S. Patent Application No. 09/876,090. This is a provisional rejection because the conflicting claims have not in fact been patented.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is directed to a method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer (Claim 25 preamble), and the '090 application is directed to a method for

creating a technical framework for use in delivering a specific set of information technology services for a customer (Claim 22 preamble).

Furthermore, the claims noted above of the present invention and the application are each directed to concepts for:

determining a solution scope specific to an information technology environment of a customer ['090] (*identifying a Systems Management solution scope* ['865]);

common practices for delivering certain types of information technology services ['090] (*identifying existing information technology within the solution scope that support the information technology environment of the customer* ['865]);

mapping existing customer information to architectural building blocks of a service delivery technical model ['090] and ['865];

describing people, processes, tools, and information used to deliver specific services to customers ['090] (*identifying which architectural building blocks are required to deliver services to the customer* ['865]); and

creating a list of design objects and designated relationships between the design objects as a function of the solution scope, wherein the design objects deliver the services to the customer in accordance with the solution scope ['090] and ['865].

For at least these reasons, one of ordinary skill would have found it obvious that the concepts for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer of the present invention ['865], and creating a technical framework for use in delivering a specific set of information technology services for a customer as in the ['090] application, are not patentably distinct in so far as the specifications of each application support the identical critical features noted above.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.1 Claims 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al (US Patent No 6,670,973).

In regard to claims 25 and 28, Hill teaches *a method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer, comprising the steps of:*

*Identifying a solution scope specific to an information technology environment of the customer* (column 2 lines 62-64, Hill discloses generating a hierarchical list(s) and graph(s) (i.e. "solution scope") for representing elements of an information technology infrastructure (i.e. "technical framework") of an organization);

*Inventorying existing information technology within the solution scope that supports the information technology environment of the customer* (column 1 lines 35-51, Hill discloses that the hierarchical list(s) and graph(s) (i.e. "solution scope") are generated by a program designed to represent the information technology infrastructure of an organization. The user of the

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program is the actual organization (i.e. “customer”) that wants its information technology infrastructure to be graphically and interactively represented by the program;

*mapping the existing information technology supporting the information technology environment of the customer to architectural building blocks of a predetermined service delivery technical model* (column 9 lines 6-8 and 12-15, Hill discloses mapping information technology elements (i.e. “customer’s existing equipment”) into levels within a hierarchical graph (i.e. “building blocks in a technical model”) of an information technology infrastructure of an organization);

*identifying which architectural building blocks are required to deliver the services to the customer in accordance with the solution scope* (column 4 lines 40-46 and column 6 line 64 – column 7 line 2, Hill discloses the hierarchical list (i.e. “technical model”) contains five levels that describe different elements and functions within an organization. It is inherent that an organization utilizes its elements and functions to deliver services to its customers),

*mapping the inventoried existing information technology components to the identified architectural building blocks, to render a list of design objects* (column 4 lines 40-46 and column 6 line 64 – column 7 line 2, Hill discloses creating a hierarchical list that contains elements of an organization (i.e. “list of design objects”)) *and relationships between the design objects that will deliver the services in accordance with the solution scope* (column 3 line 59 – column 4 line 7, Hill discloses designating relationships between organizational elements and information technology elements, all within an information technology infrastructure of an organization).

In regard to claims 26 and 29, wherein the architectural building blocks and defined relationships between the building blocks are a function of a set of predefined principles and key requirements [column 3 line 59 – column 4 line 7].



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In regard to claims 27 and 30, wherein relationships between the architectural building blocks are arranged in predefined logic levels [column 4 lines 40-46 and column 6 line 64 – column 7 line 2, Hill discloses the hierarchical list (i.e. “*technical model*”) contains five levels that describe different elements and functions within an organization.

### ***Response Guidelines***

5. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

**5.1 Any response to the Examiner in regard to this non-final action should be**

**directed to:** Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, **or** the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279. Inquires of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist (571) 272-2100.

**mailed to:** Commissioner of Patents and Trademarks  
P.O. Box 1450, Alexandria, VA 22313-1450

**or faxed to:** (571) 273-8300

Hand-delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

**Date:** 3-March-2008

/Russell Frejd/  
Primary Examiner AU 2128